UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,410	11/28/2000	Satoru Okada	723-951	4624

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EXAMINER
MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	09/722,410	OKADA ET AL.
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 February 2006</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *140-152,166-169,171-182,184-195 and 201-251* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *140,166-169,201, 204, 207, 222, and 237* is/are rejected.

7)☒ Claim(s) *141-152,171-182,184-195,202,203,205,206,208-221,223-234 and 238-251* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/30/01</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

♦

This action is Final.

♦

Information Disclosure Statement

The IDS submitted May 30th, 2001 contains references previously submitted by the

Applicant on May 18th, 2001, considered and recorded on the 1449 returned to the

Applicant on May 12th, 2003. Accordingly The May 30th, 2001 has been considered

with the consideration of the May 18th, 2001 IDS.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **140,166-169, 201, 204, 207, 222**, and **237**, are rejected under 35 U.S.C.

103(a) as being unpatentable over The Game Boy Programming Manual (c) 1999.

Claim **140** is considered representative of claims **166-169**, and the base features

of claims **201, 204, 207, 222, 237**.

The Game Boy handheld system with user-manipulable control (page 12)

includes three distinct memory portions equated to a object attribute memory (OAM), a

color palette memory, and a video memory (Page 20, "OAM RAM", "Palette RAM";

Page 12 "Display RAM).   The system further includes bitmap/character (Page 47-51)

memory for the transfer of bitmap/character data to a display memory responsive to the

actions of a user (Page 31) and displaying the contents of the display memory on a

display (Pages 51-54, and 71).

[Memory Address Ranges]

Though the claimed memory address ranges do not correlate to those presented

in the prior art the absence of defined structure or a defined function relationship with

relation to the provided memory addresses as set forth in the instant claims equates

these memory ranges to a matter of nomenclature or design choice.   One would not be

reasonably appraised from the claim language alone that a memory space from

05000000h to 050003FFh would include a fixed amount of bit storage or even the

location of said particular storage in relation to the remaining specified storage

(memory).

For example if one were to equate the claimed memory addresses to indices within a paper book, the section addressing OAM could be assigned within lines 5-185. In this example however, without defining before hand in which volume, chapter, or pages on which the line numbers are present they could very well be located at any portion in the book. In relation to this though the claims are interpreted in view the Applicant's specification they are not limited by the specification and as such though the specification may demonstrate memory configurations such as the one shown in figure 16 of the instant application the presented claims are not limited to such an interpretation.

It would have been obvious to one of ordinary skill in the art to readdress the memory ranges of Game Boy Programming Manual (c) 1999 as provided above in order to create a product that contained fixed addressed memory regions regardless of actual memory size across future upgrades.

[Storing no more than...]

The limitations directed to the storing no more than a certain amount of information in a given portion of memory at anyone time are so broad as to include the storing nothing to a given memory location. Under this interpretation storing zero 48-bit moving object definitions is well encompassed as any memory such as the one provided by the prior art above could at the very least store zero of a particular data element.

Claims **201, 204, 207, 222,** and **237** address the inclusion of an emulator in addition to the above wherein a first system emulates second system with preceding features. For the purposes of this rejection the office interprets the first system as a Game Boy system (Super Game Boy page 3) and the second system as another Game Boy system (Super Game Boy page 3). In this interpretation either unit would serve as the perfect emulator for the other meeting the claim language as presented. Further though not directly addressed in this rejection it is understood that the later versions of the Game Boy including the Game Boy Color were capable of executing Games originally intended for the original 1989 release of the Game Boy monochrome.

[The "Response to Arguments" below is incorporated herein]

Response to Arguments

Applicant's arguments filed February 6th, 2006 have been fully considered but they are not persuasive.

The Applicant argues claims **140**, and **201** require both the ability of the claimed system to selectively render character data and bitmap data however the presented claim presents these feature in the alternative and accordingly require the correlation of one of these data-types to address the claim limitation rather then both data-types. As noted by page 38 of the Applicant's response dated February 6th, 2006, *The Game Boy Programming Manual (c) 1999* teaches the inclusion of BG character data providing the correlation between the prior art and one of the alternative data types.

The Applicant argues claims **166**, and **204** describe the limitation that a memory stores instructions that access two allocated frame buffers in the video storage to provide full motion video. The cited claim limitation describes the functional ability of an instruction to provide the appearance of motion on a video screen. *The Game Boy Programming Manual (c) 1999* teaches a plurality of BG display banks (Page 51) and the ability to allow a program to select the display banks displayed on the display screen through the modification of a memory register value (Page 54). Hence as *The Game Boy Programming Manual (c) 1999* sets forth the ability to store multiple screen images in respective banks and alter the bank displayed along with the corresponding image displayed, *The Game Boy Programming Manual (c) 1999* inherently sets forth the ability to create animation and accordingly full motion video.

The Applicant argues claims **167-169, 207, 222** and **237** are argued by the Applicant for limitations directed to storing of instructions capable of performing a given function but not the realization of the respective function. The storing of a particular instruction wherein that instruction does not impart a specific modification or limitation in a memory media does not modify the structure of the invention and additionally these stored instructions do not perform the method steps associated with the particular instruction. These limitations cannot serve to patentably distinguish the claimed invention from the prior art because they represent non-functional descriptive matter, that fail to impart a modification to the apparatus or alter the method of utilization (MPEP 2106.06 & MPEP 2114).

The presented claims presently are interpreted by the Examiner as intended to encompass a computer readable media storing computer executable instructions implementing the associated claimed method. It is requested for clarity that on the occurrence of a response the Applicant state on the record which statutory class of invention that they intend for these claims to be examined under and either amend the respective claims to demonstrate the positive steps of enacting the claimed method, or alternatively clarify how the storing of an instruction would otherwise provide a distinction over the prior art of record.

Allowable Subject Matter

Claims **141-152, 171-182, 184-195, 202-203, 205-206 208-221, 223-236,** and **238-251** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

References Filed Under Seal

The office has received the References filed under Seal and has begun the process of their consideration with regards to the instant application however, as of this time the determination of applicability has not been completed with regards to the SNES Development Manual. The reference filed under seal and entitled Game Boy

Programming manual has been utilized in the rejection above and additionally cited on the attached 892.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

January 15th, 2007   MARK SAGER
RM   PRIMARY EXAMINER